

REMARKS

Claims 1-4 and 8-13 are pending.

The amendments to claims 2-4 would not narrow the scope of the amended claim recitations because R₇₀ and R₇₁ each is a H atom or optionally substituted alkyl group but R₇₀ and R₇₁ are not both H due to a proviso in claim 1 before and after the amendments to claims 2-4.

Restriction Requirement

In the Response to the Restriction Requirement filed on February 27, 2002, applicants elected to prosecute Group II, wherein at least one of R₇₀ and R₇₁ is a substituent other than H, but R₆ does not form a tricyclic group with the indole portion of the compound of formula I. However, the Examiner withdrew claims 2-4 from consideration on the merits for being drawn to non-elected subject matter because the Examiner took a position that R₇₀ and R₇₁ were not independent yet claims 2-4 recite "R₇₀ and R₇₁ independently represent a hydrogen atom or optionally substituted alkyl group." Applicants disagree because, before and after claims 2-4 have been amended as shown above, the subject matter of claims 2-4 has always fallen within the scope of the elected Group II since claims 2-4 depend on claim 1, so "the proviso that when R₇₁ is hydrogen as hereinafter described, R₇₀ is not hydrogen" recited in claim 1 should be read into claims 2-4.

However, in order to advance prosecution, applicants have replaced "R₇₀ and R₇₁ independently represent a hydrogen atom or optionally substituted alkyl group" in claims

2-4 with R₇₀ represents a hydrogen atom or optionally substituted alkyl group; R₇₁ represents a hydrogen atom or optionally substituted alkyl group." Applicants submit that claims 2-4 fall within the elected Group II. Rejoinder of claims 2-4 with claims 1 and 8-13 is requested.

Information Disclosure Statement dated October 30, 2002

The Examiner did not initial next to References AI and AJ in the copy of the PTO-1449 filed on October 30, 2002 without providing any reason. Reference AJ is an abstract of HU P9900728, the relevance of which is shown in AI, the English version of a Search Report of a corresponding Hungarian patent application. Since the submission of References AI and AJ fulfill the requirement of MPEP 609 regarding a concise explanation of the relevance for non-English language publications cited in an IDS, applicants request that the Examiner consider Reference AJ and provide applicants a copy of the PTO-1449 with his initials adjacent to Reference AJ.

Rejection of Claim 1 under 35 U.S.C. § 102

Claim 1 was rejected under 35 U.S.C. § 102(a) as being anticipated by Huang (*J. Chem. Soc.* 114, 9390, 1992). Applicants respectfully traverse the rejection.

The Examiner asserted that the peptide anticipates a compound of claim 1, wherein

R₁, R₂, R₇, R₇₁, R₇₂, R₇₃ and R₇₄ are H;

R₃ and R₇₅ are substituted alkyl;

R₆ is substituted acyl;

R₇₀ is methyl and

n is zero.

R₆ has been amended to exclude substituted acyl. Withdrawal of the rejection over Huang is requested.

Rejection of Claims 1 and 9 under 35 U.S.C. § 102

Claims 1 and 9 were rejected as anticipated by Morriello (U.S. Pat. 5,721,250).

Applicants respectfully traverse the rejection.

The anticipatory rejection is based on the compound disclosed in column 19, line 35, of Morriello. The Examiner asserted that the compound of Morriello anticipates claims 1 and 9 when

R₃ and R₇₄ are substituted ethyl;

R₇₅ is -Q'-C(O)X;

Q' is substituted -CH₂-CH₂-;

X is NH-ethyl; and

n is zero.

Applicants submit that the compound disclosed in column 19, line 35, of Morriello and the composition comprising said compound do not fall within the scopes of claims 1 and 9 because of at least three differences.

First, the compound of Morriello contains a piperidinyl moiety. In order for some the compounds of formula I shown in claim 1 to form a piperidinyl moiety, **R₇₄ and R₃ must together form a piperidinyl ring** having the N atom to which R₇₄ is attached as a ring nitrogen atom. However, **in claim 1, R₇₄ and R₃ do not together form a ring.** R₇₄

and R₃ are two separate R groups. Even when R₇₄ and R₃ are two substituted alkyl groups, the two substituted alkyl groups do not join to form any ring, so unlike the compounds of Morriello the compounds of claim 1 do not form a piperidiny ring attached to the carbonyl group of the tryptophan derivative.

Second, in the compounds of claim 1, the N atom of the amido bond to which R₇₄ is attached is separated from the adjacent carbonyl group by **one** carbon atom, i.e. the carbon atom to which R₃ is attached. However, in Morriello's compound, the ring N atom of the piperidiny moiety is separated from a carbonyl group by **two** carbon atoms, i.e. positions 2 and 3 of the piperidiny ring.

Third, in Formula I of claim 1, when

R₃ and R₇₄ are substituted ethyl;

R₇₅ is -Q'-C(O)X;

Q' is substituted -CH₂-CH₂-;

X is NH-ethyl; and

n is zero,

the compounds of claim 1 actually have at least one more amido bond than Morriello's compound due to

R₇₅ being -Q'-C(O)X;

Q' being substituted -CH₂-CH₂-; and

X being NH-ethyl.

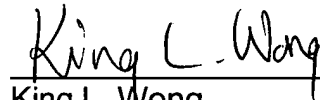
Withdrawal of the rejection over Morriello is requested.

Conclusion

In view of the amendments and the above reasoning, applicants submit that the application is in a condition for allowance. A Notice of Allowance is believed in order.

In the event that the filing of this paper is not deemed timely, applicants petition for an appropriate extension of time. Any petition fee for the extension of time and any other fees that may be required in relation to this paper can be charged to Deposit Account No. 01-2300, referencing Docket No. 108281-00001.

Respectfully submitted,



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